

## **REMARKS/ARGUMENTS**

### **Claim Objections**

The Examiner pointed out that **claims 4, 5, and 10-16** were improper multiple dependent claims. The applicant agrees. Claims 1-16 were canceled. The new claims 17-55 are in proper dependent format.

The Examiner further pointed out that the claim format of claims 12 and 13 were unclear as to what steps are included in the method claim format. The applicant agrees. Claims 1-16 were canceled. The new claims 17-55 are in proper method claim format.

The Examiner still further pointed out that the abstract would include indefinite language. The applicant agrees and submitted a replacement abstract herewith. No new matter was added as the language uses *verbatim* elements from the claims as originally filed.

### **35 USC § 112**

**Claims 1-3 and 6-9** were rejected under 35 USC § 112, second paragraph, as being indefinite for lack of identifiable method steps and further use of nested ranges. The applicant agrees. Claims 1-16 were canceled. The new claims 17-55 are in proper claim format.

### **35 USC § 102**

**Claims 1, 3, and 6-7** were rejected under 35 USC § 102 as being anticipated by U.S. Pat. No. 5,480,469 (Storstrom et al.). The applicant respectfully disagrees for various reasons. Nevertheless, the applicant canceled claims 1-16 and provided new claims 17-55.

With respect to the newly filed claims, the applicant points out that Storstrom et al. teach powder metallurgical mixtures containing a base metal powder, pulverulent additives, optionally a lubricant and a binder, wherein the binder is at least one diamide wax. In contrast to the present invention, no surface-modified manganese sulfide is mentioned by Storstrom et al. Moreover, Storstrom's binder is a diamide wax, which is clearly not part of the coating agent of the presently pending claims. More specifically, the coating agent of the presently pending claims is limited to a wax, an ester of an inorganic or organic acid, an oil, a low-melting polymer or a

mono- to multi-functional aliphatic alcohol with 2 to 12 carbon atoms or mixtures thereof. The specification defines waxes as esters of higher straight-chained fatty acids such as palmitic acid, hexacosanoic acid with higher straight-chained, monofunctional alcohols such as palmityl alcohol, stearyl alcohol or octadec-9-en-1-ol or such waxes as Japan wax, lanolin, beeswax or low-molecular polyethylene glycols and polypropylene glycols. Thus, the coating agents of the present claims are entirely inconsistent with the diamide wax of Storstrom et al. Consequently, claims 17-55 are not anticipated by nor obvious over Storstrom et al.

### **35 USC § 103**

**Claims 1, 2, and 6-8** were rejected under 35 USC § 103 as being obvious over U.S. Pat. No. 5,768,678 (Chopra et al.) in view of U.S. Pat. No. 6,287,513 (Grady et al.). The applicant respectfully disagrees for various reasons. Nevertheless, the applicant canceled claims 1-16 and provided new claims 17-55.

With respect to the newly filed claims, the applicant points out that Chopra et al. teach machining aids based on a manganese sulfide composition, which contains besides manganese sulfide additionally iron. Example 18 discloses, that this composition can contain additionally a binder. Grady deals with a method of shaping powder metal parts, wherein the powder metal consists of iron or iron alloy and additionally a thermoplastic binder. According to the Examiner's opinion, the combination of the thermoplastic binder with the manganese sulfide composition of Chopra would lead the skilled man directly to the teaching of the present invention.

However, the applicant points out that neither Chopra nor Grady teach or suggest use of the coating agents as presently claimed. On the contrary, Chopra uses iron in his compositions, which clearly teaches away, if not even against the presently pending claims. Iron is simply inconsistent with meltable and evaporable coating agents as presently claimed.

Furthermore, Chopra et al. teach a process where manganese, sulfur and iron are reacted leading *inter alia* to manganese sulfide. Thus, no coating is described. According to example 18, a binder can be included in the use of said composition with a metal powder in a sinter process, *i.e.*, such binder is added to the mixture of manganese sulfide, iron and metal. In contrast, the

manganese sulfide according to the presently pending claims is coated first, and than used with a metal in a sinter process. Therefore, the newly filed claims are also not obvious over Chopra in view of Grady.

In view of the present amendments and arguments, the applicant believes that all claims are now in condition for allowance. Therefore, the applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

RUTAN & TUCKER

By

  
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Martin Fessenmaier, Ph.D.

Reg. No. 46,697

Tel.: (714) 641-5100